

## **REMARKS**

### **I. Status of Claims**

Claims 1-35 are pending. Claims 4, 6, 7, 13, 15-21, 24-29, 31, 33, and 34 stand withdrawn from consideration as reciting non-elected subject matter further to the election of species requirement dated September 10, 2007. Applicants respectfully remind the Office of the duty of rejoinder. See MPEP § 803.02 and 35 U.S.C. § 121. The claims are not amended herein.

### **II. Rejections Under 35 U.S.C. § 103(a)**

The Office maintains the rejection of claims 1-3, 5, 8-12, 14, 22, 23, 30, 32, and 35 under 35 U.S.C. § 103(a) as allegedly "being unpatentable over" U.S. Patent No. 6,361,767 to Malle et al. ("the '767 patent") for the reasons set forth in the Office Action mailed June 11, 2008 and the Final Office Action mailed March 5, 2009. In the Final Office Action, the Office states that "even though the claims recite 'activate hair by non-reducing activation', the same hair population is treated . . . using the same polymer (polyethyleneimine of example 8) and applying to the activated hair cosmetically active compound, which is claimed dye (col. 12, colorant graft step)." Final Office Action at 6. The Office further states "The expression 'comprising' in the claims are inclusive [of] unrecited steps of the patent." *Id.* Applicants continue to traverse this rejection for reasons of record and at least the following reasons.

As Applicants have previously stated, the '767 patent describes a method for treating hair keratin fibers by reducing the sulphur bonds to generate reactive sites, whereas the present claims recite "non-reducing activation." See Amendment and Reply to Office Action dated December 10, 2008. The Office's statement that the "same

polymer (polyethyleneimine of example 8)" of the pending claims is present in the '767 patent is false. The '767 patent example 8 discloses "a branched polyethyleneimine polymer carrying thiol functions." '767 col. 11, lines 45-46 (emphasis added). The presence of the thiol functions on the polyethyleneimine is further underscored by the thiol concentration disclosed "(thiol titre: 1220 meq/l)" in the '767 patent. *Id.* at line 47. The thiol functions of the '767 patent allow the compound to reduce the disulphide bonds on the keratin fibers. *See id.* at lines 44-46 and 66-67 ("After this reduction step . . . ") Any skilled artisan knows that thiol functions are reducing agents. Thus, the '767 polymers are not the "same polymer," as in the present claims; the difference being the '767 polymers are reducing agents and, in contrast, the polymers of the present application do not carry any thiol functions because the compound activates the hair without reducing the disulphide bonds of the hair. They do not and cannot teach or suggest non-reducing activation.

Contrary to the allegations of the Examiner, the same hair population is clearly treated in a different manner in the '767 patent than in the present application. The present claims recite "a non-reducing step of activation of the hair." This step necessitates a non-reducing component. Thiol functions would automatically reduce the disulphide bonds of the hair, which is outside the scope of the present claims. Therefore, the branched polyethyleneimine of the '767 patent is structurally and functionally different from the polyethyleneimine used in the present application.

In an obviousness determination, the Office must consider the reference teachings as a whole, taking into consideration portions that would lead away from the claimed invention. *See* M.P.E.P. § 2141.02 (citing *W.L. Gore & Assoc., Inc. v. Garlock*,

*Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983)). "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Gurley*, 27 F.3d 551, 553, 31 U.S.P.Q.2d 1130, 1131 (Fed. Cir. 1994) (emphasis added).

The '767 patent teaches away from the present claims as it teaches reducing, whereas the present claims recite "non-reducing." Moreover, any proposal by the Office to modify the '767 patent to obtain the present claims would cause the art to become inoperable or destroy its intended function, thus precluding the requisite motivation from being present. See *In re Fritch*, 972 F.2d 1260, 1265-66, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). Indeed, since the compound used in the '767 patent is a reducing agent, the hair would be activated by reducing activation of the hair. In addition, the '767 patent discloses a comparative study that demonstrates that the lock of hair, "which had not undergone prior reduction, had a very slight coloration which was only just discernible with the naked eye." The '767 patent at col. 12, lines 42-53. Therefore, a skilled artisan following the teachings of the '767 patent would be led in a direction divergent from the path taken by the applicant.

Moreover, the '767 patent does not motivate a process comprising non-reducing activation of the hair. Indeed, the entire purpose of the '767 patent is to reduce the disulphide bonds of the keratin fibers in order to generate reactive sites on the surface to a depth of less than 10 $\mu$ m. See '767 Abstract. Therefore, this patent would not have given any suggestion to the man skilled in the art to use non-reducing components in order to activate the keratin fibers.

For at least these reasons, the '767 patent does not teach or suggest the present claims and, in fact, teaches away from the presently claimed invention. Thus, the '767 patent cannot serve as a proper basis for a *prima facie* case of obviousness and the rejection should be withdrawn.

### III. Conclusion

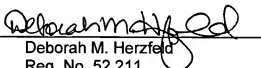
In view of the foregoing, Applicants respectfully request reconsideration of the pending claims and their timely allowance.

Please grant any extensions of time required to enter this paper and charge the required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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